

### **REMARKS**

This is a full and timely response to the non-final Office Action of June 18, 2003.

Reexamination, reconsideration, and allowance of the application and all presently pending claims are respectfully requested.

Upon entry of this Third Response, claims 1-40 remain pending in this application, and claims 29 and 38 are directly amended herein. It is believed that the foregoing amendments add no new matter to the present application.

### **Response to §103 Rejections**

In order for a claim to be properly rejected under 35 U.S.C. §103, the combined teachings of the prior art references must suggest all features of the claimed invention to one of ordinary skill in the art. See, e.g., *In Re Dow Chemical*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988), and *In re Keller*, 208 U.S.P.Q. 871, 881 (C.C.P.A. 1981). In addition, “(t)he PTO has the burden under section 103 to establish a *prima facie* case of obviousness.” *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988) (Citations omitted). Furthermore, the Federal Circuit has stated that “(i)t is impermissible, however, to simply engage in hindsight reconstruction of the claimed invention, using the applicant’s structure as a template and selecting elements from references to fill the gaps.” *In re Gorman*, 933 F.2d 982, 987, 18 U.S.P.Q.2d 1885 (1991).

### Claim 1

Claim 1 presently stands rejected under 35 U.S.C. §103 as purportedly being unpatentable over *Moore* (U.S. Patent No. 5,649,402) in view of *Pennell* (6,028,566). Claim 1 presently reads as follows:

1. A system for supporting wireless communication equipment, comprising:
  - a foundation;
  - a guyed tower* fixedly attached to said foundation; and
  - a pole tower* fixedly attached to said foundation and *extending through a middle region of said guyed tower*. (Emphasis added).

Applicant respectfully asserts that the alleged combination of *Moore* and *Pennell* fails to suggest or teach at least the features of pending claim 1 highlighted hereinabove.

In rejecting claim 1, it is asserted in the Office Action that:

“Moore teaches a self-supported tower, not a guyed tower surrounding the pole tower. However, guyed towers and self-supported towers are both conventional towers and are well known in the art to support antennas, as taught by *Pennell* (column 5, lines 27-35). *Pennell* indicates that self-supporting towers or guyed towers could be utilized in his invention. Guyed towers and self-supporting towers are considered functional equivalents in the art, therefore it would be obvious to one having ordinary skill in the art at the time the invention was made to use a guyed tower with *Moore*’s pole tower.”

Applicant respectfully traverses the assertion that it would have been obvious to “use a guyed tower with *Moore*’s pole tower,” as alleged in the Office Action. In this regard, “(t)he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.” *In re Fritch*, 972 F.2d 1260, 1266, 23 U.S.P.Q. 2d 1780 (Fed. Cir. 1992). Applicant asserts that the alleged modification of *Moore* is not properly based on teachings from the cited art but is rather based on impermissible hindsight reconstruction of Applicant’s invention.

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hindsight

In this regard, Applicant notes that there must not only be a suggestion to combine the functional or operational aspects of the combined references, but that the Federal Circuit also requires the prior art to suggest both the combination of elements and the structure resulting from the combination. *Stiftung v. Renishaw PLC*, 945 Fed.2d 1173 (Fed. Cir. 1991). Therefore, in order to sustain an obviousness rejection based upon a combination of any two or more prior art references, the cited art must properly suggest the desirability of utilizing the modified structure, and merely alleging that the modified structure is a "functional equivalent" of the structure described by a prior art reference is insufficient for establishing a *prima facie* case of obviousness.

To better illustrate the foregoing concepts, Applicant refers to *Continental Can Co., USA, Inc. v. Monsanto Co.*, 948 F.2d 1264 (Fed. Cir. 1991). In that case, the claimed invention was directed to a ribbed bottom structure for reinforcing a plastic container. The patent in suit claimed that each container rib was hollow. The prior art consisted of several patents directed to ribbed configurations comprising the support structure of plastic container bottoms. The primary reference was a *Marcus* patent, which disclosed a plastic container having a ribbed bottom, wherein the ribs were solid. A *Pentaloid* patent was a secondary reference which, when inverted, closely resembled the claimed invention. The Federal Circuit, however, quickly dismissed this simple modification as constituting an obvious change by stating "(a)lthough a prior art device could have been turned upside down, that did not make the modification obvious unless the prior art fairly suggested the desirability of turning the device upside down." *Continental Can* at 1270.

Moreover, Applicant asserts that the Office Action fails to show that the cited art provides a motivation or desirability for replacing the self supporting tower of *Moore* with a guyed tower, as alleged in the Office Action. Thus, Applicant asserts that the Office Action fails to establish a

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*prima facie* case of obviousness and that the rejection of claim 1 is based on impermissible hindsight reconstruction of Applicant's invention.

In addition, it is well settled law that the teachings of the prior art must be considered "as a whole" for what they suggest to one of ordinary skill in the art. "On the issue of obviousness, the combined teachings of the prior art as a whole must be considered." *EWP Corp. v. Reliance Universal Inc.*, 755 F.2d 898, 225 U.S.P.Q. 20, 25 (Fed. Cir. 1985). Applicant asserts that when the prior art is properly viewed "as a whole," it becomes readily apparent that the alleged combination of *Moore* and *Pennell* would not have been obvious to one of ordinary skill in the art.

In this regard, there is nothing in the cited art to suggest that a "pole tower" should be erected within a "guyed tower" for the purpose of providing mechanical support *to the "guyed tower,"* as taught by the instant application. In fact, *Moore* specifically teaches that the self supported tower 11 is to provide mechanical support *to the inner column 29*. See column 3, lines 12-13. There is nothing in *Moore*, or any of the other cited art references, to indicate the desirability of placing a "pole tower" within a "guyed tower" for the purpose of supporting the "guyed tower."

Furthermore, despite the Office Action assertions that guyed towers and self supported towers are "functional equivalents," Applicant respectfully asserts that the design of guyed towers and self supported towers are substantially different. In this regard, lateral support in a self supported tower is provided by the tower's structural beams, whereas lateral support in a guyed tower is substantially provided by guyed wires. Indeed, self supported towers of the type shown by *Moore* inherently have greater lateral stability and less sway than most, if not all, guyed towers. In addition, applicant submits that, according to the teachings of *Moore*, it would appear to one of

ordinary skill in the art that erecting a “pole tower” within a “guyed tower” would substantially increase the lateral loads placed *on the “guyed tower”* in a generally unpredictable fashion as the “pole tower” and the “guyed tower” sway. Thus, one of ordinary skill in the art, upon reading *Moore*, would be discouraged from erecting a “pole tower” within a “guyed tower.”

In direct contrast to the teachings of *Moore*, the instant application teaches that erecting a pole tower within a guyed tower can actually enhance the stability *of the guyed tower*. Moreover, when the prior art teachings and present invention are properly considered “as a whole,” it becomes apparent that *Moore* teaches away from the present invention, as defined by claim 1, and *Moore*, therefore, should not be used to reject this claim. “A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant... in general, *a reference will teach away if it suggests that the line of development flowing from the reference’s disclosure is unlikely to be productive of the result sought by the applicant.*” *In re Gurley*, 2 F.3d 551, 31 U.S.P.Q.2d 1130, 1131 (Fed. Cir. 1994). (Emphasis added).

*combination improper*  
For at least the foregoing reasons, Applicant submits that the alleged combination of *Moore* and *Pennell* is improper, and the rejection of claim 1 should be withdrawn.

### Claims 2-10 and 30-33

Claim 2-10 and 30-33 presently stand rejected in the Office Action under 35 U.S.C. §103 as allegedly being unpatentable over *Moore* in view of *Pennell*. Applicant submits that the pending dependent claims 2-10 and 30-33 contain all features of their respective independent claim 1. Since

claim 1 should be allowed, as argued hereinabove, pending dependent claims 2-10 and 30-33 should be allowed as a matter of law for at least this reason. *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988). In addition, these dependent claims recite patentable features that make them allowable notwithstanding the allowability of pending claim 1.

For example, claim 30 recites “wherein said pole tower is positioned such that at least one point on said guyed tower engages said pole tower ***as said guyed tower sways.***” (Emphasis added). Applicant submits that the cited art and, in particular, *Moore* fails to teach and, in fact, teaches against such features. In this regard, *Moore* specifically teaches that “Tie braces 41, 43 and 45 provide lateral support to column (29), preventing it from swaying or bending due to wind.” Column 3, lines 27-29. Thus, it appears that the column 29 is rigidly coupled to the tower 11 and, therefore, does not “engage” the tower 11 as it sways. Accordingly, the cited art fails to teach or suggest each of the features of claim 30, and the rejection of this claim should be withdrawn, notwithstanding the allowability of independent claim 1.

### **Claim 11**

Claim 11 presently stands rejected under 35 U.S.C. §103 as allegedly being unpatentable over *Moore* in view of *Pennell*. Claim 11 presently reads as follows:

11. A system for supporting wireless transmission equipment, comprising:  
a foundation;  
***a guyed tower*** fixedly attached to said foundation; and  
***a means for absorbing bending moments that act on said guyed tower, said absorbing means fixedly attached to said foundation and extending through a middle region of said guyed tower.*** (Emphasis added).

For at least the reasons set forth hereinabove in the arguments for allowance of pending claim 1, Applicant asserts that the combination of *Moore* and *Pennell* fails to suggest at least the features of claim 11 highlighted hereinabove. Accordingly, Applicant respectfully submits that the rejection of claim 11 is improper and should be withdrawn.

### Claims 12-18

Claims 12-18 presently stand rejected in the Office Action under 35 U.S.C. §103 as allegedly being unpatentable over *Moore* in view of *Pennell*. Applicant submits that the pending dependent claims 12-18 contain all features of their respective independent claim 11. Since claim 11 should be allowed, as argued hereinabove, pending dependent claims 12-18 should be allowed as a matter of law for at least this reason. *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

### Claim 19

Claim 19 presently stands rejected under 35 U.S.C. §103 as allegedly being unpatentable over *Moore* in view of *Pennell*. Claim 19 presently reads as follows:

19. A method for supporting wireless communication equipment, comprising the steps of:  
erecting a guyed tower;  
fixedly attaching said guyed tower to a foundation;  
***erecting a pole tower within a middle region of said guyed tower***; and  
fixedly attaching said pole tower to said foundation. (Emphasis added).

For at least the reasons set forth hereinabove in the arguments for allowance of pending claim 1, Applicant asserts that the combination of *Moore* and *Pennell* fails to suggest at least the features of claim 19 highlighted hereinabove. Accordingly, Applicant respectfully submits that the rejection of claim 19 is improper and should be withdrawn.

The rejection of such claims are improper or the combination of *Moore* & *Pennell* fails to suggest.  
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### Claim 20

Claim 20 presently stands rejected under 35 U.S.C. §103 as allegedly being unpatentable over *Moore* in view of *Pennell*. Claim 20 recites the step of “erecting a pole tower within a middle region of said guyed tower.” For at least the reasons set forth hereinabove in the arguments for allowance of pending claim 1, Applicant asserts that the combination of *Moore* and *Pennell* fails to suggest such features. Accordingly, Applicant respectfully submits that the rejection of claim 20 is improper and should be withdrawn.

### Claims 21-28, 34, and 35

Claims 21-28, 34, and 35 presently stand rejected in the Office Action under 35 U.S.C. §103 as purportedly being unpatentable over *Moore* in view of *Pennell*. Applicant submits that the pending dependent claims 21-28, 34, and 35 contain all features of their respective independent claim 20. Since claim 20 should be allowed, as argued hereinabove, pending dependent claims 21-28, 34, and 35 should be allowed as a matter of law for at least this reason. *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988). In addition, these dependent claims recite patentable features that make them allowable notwithstanding the allowability of pending claim 20.

For example, claim 34 recites “positioning said pole tower within said middle region such that at least one point on said guyed tower engages said pole tower *as said guyed tower sways*.” (Emphasis added). For at least the reasons set forth hereinabove in the arguments for allowance of claim 30, Applicant submits that the cited art fails to suggest at least the foregoing features of claim



34. Thus, the rejection of claim 34 is improper and should be withdrawn, notwithstanding the allowability of independent claim 20.

### **Claim 29**

Claim 29 presently stands rejected under 35 U.S.C. §103 as allegedly being unpatentable over *Moore* in view of *Pennell*. Claim 29, as amended, reads as follows:

29. A method for increasing a load capacity of a previously erected guyed tower, comprising the steps of:  
***erecting a pole tower within an inner region of said previously erected guyed tower***; and  
attaching said pole tower to a foundation. (Emphasis added).

Applicant submits that the cited art fails to provide a motivation for erecting a “pole tower” within a “guyed tower” *after* the “guyed tower” has previously been erected. Thus, the cited art fails to suggest at least the features of claim 29 highlighted hereinabove. Accordingly, the rejection of claim 29 under 35 U.S.C. §103 is improper and should be withdrawn.

### **Claims 36 and 37**

Claims 36 and 37 presently stand rejected under 35 U.S.C. §1.03 as purportedly being unpatentable over *Moore* in view of *Pennell*. Applicant submits that the pending dependent claims 36-40 contain all features of their respective independent claim 29. Since claim 29 should be allowed, as argued hereinabove, pending dependent claims 36-40 should be allowed as a matter of law for at least this reason. *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988). In addition, these dependent claims recite patentable features that make them allowable notwithstanding the allowability of pending claim 29.

For example, claim 36 recites “positioning said pole tower within said inner region such that at least one point on said guyed tower engages said pole tower *as said guyed tower sways.*” (Emphasis added). For at least the reasons set forth hereinabove in the arguments for allowance of claim 30, Applicant submits that the cited art fails to suggest at least the foregoing features of claim 36. Thus, the rejection of claim 36 is improper and should be withdrawn, notwithstanding the allowability of independent claim 29.

#### **Allowable Subject Matter**

Claims 32 and 38-40 have been indicated as allowable by the outstanding Office Action if such claims are rewritten to include the limitations of their respective base claims. Accordingly, pending claim 38 has been amended herein to include the features of its respective base claim 29, and Applicant respectfully requests that the objections to claim 38, as well as claims 39 and 40, which depend from claim 38, be withdrawn.


Further, claim 32 includes all of the features of its respective base claim 1, which is allowable as indicated hereinabove. Thus, claim 32 is allowable as a matter of law. *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

### **CONCLUSION**

Applicant respectfully requests that all outstanding objections and rejections be withdrawn and that this application and all presently pending claims be allowed to issue. If the Examiner has any questions or comments regarding Applicant's response, the Examiner is encouraged to telephone Applicant's undersigned counsel.

Respectfully submitted ,

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